R E M A R K S

To avoid the specification objection, the specification was amended to revert to the first data, third data, fourth data, and fifth data.

The claim objections to claims 29-30, 38 and 41 are avoided by the amendments herein. With respect to claim 30, it is noted the independent claim 23 from which claim 30 depends recites "a print image" on the register tab. Therefore reference to a further print image is correct.

The Examiner rejected claims 23-25, 27-28, 30-32, 36, 38, 39, and 41 under 35 U.S.C. §103 as unpatentable over Sunada in view of Motamed, further in view of Tischer.

With respect to the primary reference Sunada, claim 23 recites the first data containing information for formatting of elements of at least one separator sheet where those elements are to be printed on a register tab and not on a remainder of the separator sheet outside of the register tab and where that first data is stored in a first file which is separate from any print data for said remainder of the separator sheet outside of the register tab. The claim also distinguishes by reciting generating a third data in an additional file which is separate from any print data for said remainder of the separator sheet outside of the register tab. Finally, claim 23 recites generating a second data by processing the first data and the third data, and wherein with aid of the second data print data for generation of a print image on the register tab are added to a print data stream containing said any print data for said remainder of said separator sheet outside of the register tab. Sunada teaches directly away from this in Figure 9 where the image forming area not only includes the tab but also the entire body of the tab sheet in addition to the tab. It is important with the present

invention to process data of the register tab separate from any data for a remaining portion of the separator sheet.

Sunada teaches away by treating information to be printed on tab sheets the same as information printed on a regular text sheet. See Sunada paragraph 0076 wherein pages of tab sheet documents are shifted by an amount corresponding to the extension amount of the tab to the edge of the tab sheet. For the separator sheet there is no distinction made between information to be printed on the tab area and information to be printed on the remaining area.

With this difference pointed out above in claim 23, with the present invention it is possible to process data of tab areas different to data of the remaining area of the tab separator sheet. For example, it is possible to rotate only information of the tab area or to adapt this information to different kinds of tab sheet sets (see Substitute Specification page 7, lines 28-32), whereas information on the remaining area of the separator sheet is handled the same as information of regular sheets of a print job.

Claim 23 also recites both first data which is the formatting of the elements for the tab and third data which is the data of the elements to be printed on the register tab. The Examiner agrees that Sunada does not have the first data for formatting. For this feature, the Examiner cites the secondary reference Motamed which the Examiner asserts generates the first data (font type and size) for formatting of elements. However, Motamed does not satisfy the above-noted deficiencies of the primary reference Sunada because Motamed only discloses creating data for register tabs *only* suggestion of the stream having print data for the remainder of the separator sheet outside of the tab and second data derived from a first formatting data file and a third data for printing the elements being added to the print data stream which contains any print data for the remainder of the separator sheet

outside of the register tab. There is no disclosure in Motamed for any possibility to print data on the remainder of the separator sheet. In Motamed, the separator sheets contain only data within the register tab area.

Furthermore, since Sunada teaches printing on the entire separator page, both tab and remainder, with a common data filer, one skilled in the art would not combine Motamed with Sunada since Motamed teaches printing only the register tab.

Tischer discloses rapid creation and display of stylized digital content items by applying a style definition of one of the plurality of second files to the digital content item of the first file (see abstract). There is no mention in this reference of separator sheets for tabs and therefore clearly no disclosure of providing a first format data and third content data for a tab and wherein those data files allow separate creation of a second data file separate from printing data for the remainder of the separator sheet. Thus Tischer does not teach the above-noted deficiencies of Sunada combined with Motamed.

Dependent claims 24-40 distinguish at least for the reasons noted with respect to claim 23 and also by reciting additional features not suggested.

Particular attention is drawn to dependent claim 30 reciting the fifth data for generation of a further print image in at least one section of said remainder of the separator sheet outside of the register tab. Sunada only teaches a single file for print data throughout his separator sheet – namely on both the tab and the remainder portions of the separator sheet outside of the tab.
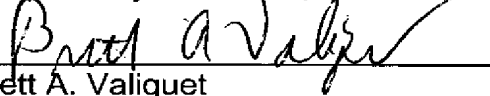
Independent claim 41 distinguishes at least for the reasons noted with respect to independent claim 23.

Additional dependent claim 43 has been added reciting four steps of selecting a template as the first formatting data, printing text as the third data for the register tab, additional print data as the fifth data for output on the remaining portion of the separator sheet, and associating the additional data with the separator sheet. This claim also clearly distinguishes over the combination of references relied on by the Examiner.

Allowance of the application is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required, or to credit any overpayment to account No. 501519.

Respectfully submitted,

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